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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|------------------------|---|
| Proceeding | 92062400 |
| Party | Defendant Avalon IP Holding Co. |
| Correspondence Address | AVALON IP HOLDING CO 1729 ABBOT KINNEY BOULEVARD VENICE, CA 90291 UNITED STATES knye@ngelaw.com, leulgen@ngelaw.com, temanuelson@ngelaw.com |
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| Date | 12/16/2015 |
| Attachments | AVALON -- Answer to Petition for Cancellation_.pdf(29518 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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| | | |
|------------------------------|---|---------------------------|
| AvalonBay Communities, Inc., |) | |
| |) | |
| Petitioner, |) | |
| |) | |
| v. |) | Cancellation No. 92062400 |
| |) | |
| Avalon IP Holding Co. LLC, |) | |
| |) | |
| Registrant. |) | |

ANSWER TO PETITION FOR CANCELLATION

1. AvalonBay, including through its predecessors in interest, has been in the business of developing, redeveloping, acquiring and managing high-quality residential communities in the United States since at least as early as 1978.

ANSWER: Registrant has insufficient knowledge or information to form a belief as to the allegations of this Paragraph of the Petition for Cancellation and therefore denies the same.

2. On information and belief, Registrant Avalon IP Holding Co. (“Registrant”), a California limited liability company with an address of 1729 Abbot Kinney Boulevard, Venice, California 90291, is the owner of U.S. Trademark Registration No. 4043653 for “Hotel and resort lodging services; provision of general purpose facilities for meetings, conferences and exhibitions; reservation services for hotel room accommodations; restaurant and bar services” in International Class 43 (“Registrant’s Services”). This registration issued on October 25, 2011.

ANSWER: Admitted.

3. Upon information and belief, Registrant operates a hotel that includes villa-style residences with full living rooms, dining rooms, and kitchens, as well as a pool and fitness area, much like many of AvalonBay's apartment communities.

ANSWER: Registrant admits that it operates 13 villa-style hotel suites at its Avalon Hotel in Palm Springs. Registrant denies any remaining allegations of this Paragraph of the Petition for Cancellation.

4. AvalonBay is the owner of numerous incontestable registrations incorporating AVALON (the "AVALON marks"), including the following:

| TRADEMARK | REG. NO. | REG. DATE | GOODS/SERVICES |
|----------------------------|-----------|--------------------|---|
| AVALON PROPERTIES & Design | 1,871,559 | January 3, 1995 | Class 36: Real estate investment trust services |
| AVALONBAY | 2,618,414 | September 10, 2002 | Class 36: Managing, operating, leasing, appraising, brokering, investing in, and valuing real property; financial investment in the field of real property |
| AVALON & Design | 2,799,153 | December 23, 2003 | Class 16: Paper, printed and cardboard articles, namely address labels, survey answer sheets on the subject of real property and residential services, printed charts; printed guides for real property; printed guides for residential services; periodical publications namely news letters, journals, and magazines relating to real property and residential services |
| AVALON & Design | 2,887,466 | September 21, 2004 | Class 36: Real estate management, leasing, appraisal, investment, brokering, and valuation, and providing information on residential services in the management insurance, multi-family housing management and residential support services, and neighborhood guides Class |

| TRADEMARK | REG. NO. | REG. DATE | GOODS/SERVICES |
|-----------------------------|-----------|--------------|---|
| | | | 37: Providing online information in the field of residential services, namely residential property construction and the planning of residential communities |
| AVALON COMMUNITIES & Design | 2,950,378 | May 10, 2005 | <p>Class 36: Managing, operating, maintaining, leasing and investing in real property; financial investment in the field of real property; providing online information for renters and prospective renters</p> <p>Class 37: Real estate development, construction and repair of buildings; planning and laying out of residential communities, real estate site selection; providing online information in the field of residential services, namely, real estate development, construction, maintenance and repair of buildings</p> <p>Class 39: Providing information on storage and moving services for real property residents and prospective residents</p> |
| AVALON COMMUNITIES & Design | 2,950,379 | May 10, 2005 | <p>Class 36: Providing information in the field of real property, namely, real estate management, leasing and residential property listings</p> <p>Class 37: Real estate development, construction and repair of buildings; planning and laying out of residential communities, real estate site selection; providing online information in the field of residential services, namely, real estate development, construction, maintenance and repair of buildings</p> |
| AVALON | 3,101,896 | June 6, 2006 | Class 16: Paper and cardboard articles namely address labels, survey answer sheets, notebooks, picture books, calendars, announcement cards, blank cards, postcards, note cards, business cards, paper mats, printed charts, |

| TRADEMARK | REG. NO. | REG. DATE | GOODS/SERVICES |
|-----------|----------|-----------|---|
| | | | <p>stationery, posters, signs; decals; drawing pencils; photographs; plastic bags; ball point pens; binders; bulletin boards; printed guides for real property; printed guides for residential services; periodical publications namely news letters, journals, and magazines relating to real property and residential services</p> <p>Class 35: Real estate marketing services, namely, providing advertising information on residential services for others</p> <p>Class 36: Managing, operating, maintaining, leasing, appraising, brokering, investing in, and valuing real property; purchasing real property for others; financial investment in the field of real property; providing online information for renters and prospective renters; providing information regarding real estate and rental insurance</p> <p>Class 37: Real estate development, construction and repair of buildings; planning and laying out of residential communities, real estate site selection; providing online information in the field of residential services, namely, real estate development, construction, maintenance and repair of buildings</p> <p>Class 39: Providing information on storage and moving services for real property residents and prospective residents</p> <p>Class 41: Providing online information and listings of the social events of others; providing information regarding community activities in the nature of</p> |

| TRADEMARK | REG. NO. | REG. DATE | GOODS/SERVICES |
|-----------------------------|-----------------|-------------------|--|
| | | | <p>social events</p> <p>Class 42: Providing information regarding architectural floor plans and furniture arrangement within floor plans</p> <p>Class 45: Providing online information regarding the security goods and services of others</p> |
| AVALONBAY | 3,154,668 | October 10, 2006 | <p>Class 16: Posters</p> <p>Class 35: Real estate marketing services, namely providing online tours and images of residential real estate and other property</p> |
| AVALON COMMUNITIES & Design | 3,174,681 | November 21, 2006 | <p>Class 16: Paper and cardboard articles namely calendars, postcards, posters, ball point pens; printed guides for real property; printed guides for residential services</p> <p>Class 41: Providing online information and listings of the social events of others</p> <p>Class 45: Providing online information regarding the security goods and services of others</p> |
| AVALON COMMUNITIES & Design | 3,419,667 | April 29, 2008 | <p>Class 16: Ball point pens; printed guides for real property; printed guides for residential services</p> <p>Class 41: Providing online information and listings of the social events of others, namely, organizing, arranging, and hosting social events, get togethers, and parties for community members</p> |
| AVALON COMMUNITIES | 3,423,982 | May 6, 2008 | <p>Class 35: Dissemination of advertising for others</p> <p>Class 36: Real estate appraisal, investment, and financial valuation</p> |

| TRADEMARK | REG. NO. | REG. DATE | GOODS/SERVICES |
|-----------|-----------|------------------|--|
| AVALON | 3,523,079 | October 28, 2008 | <p>Class 16: Printed guides for real property; Printed guides for residential support services and community information; periodical publications, namely, newsletters in the field of real property, residential support services, and community information</p> <p>Class 35: Providing online tours and images of real estate; providing online classified advertisements; real estate marketing services, namely, providing advertising information for others in the field of residential support services and community information; bringing together, for the benefit of others, a variety of goods and services to enable customers to conveniently view and purchase those goods and services</p> <p>Class 36: Multi-family housing management, namely, real estate management; residential support services, namely, managing and leasing real property; providing online information for renters and prospective renters of real property; and providing information regarding real estate and rental insurance</p> <p>Class 37: Real estate development, construction, and maintenance; and providing online information in the field of residential services, namely, maintenance and repair of buildings</p> <p>Class 41: Providing recreational and exercise facilities</p> <p>Class 42: Computer services, namely, providing an online community for social networking</p> |

ANSWER: Registrant has insufficient knowledge or information to form a belief as to the allegations of this Paragraph of the Petition for Cancellation and therefore denies the same.

5. AvalonBay has used its AVALON marks in connection with residential real estate and other services since at least as early as 1994, well before the filing of Registrant's application to register the mark AVALON on October 29, 2008, and claimed first use date of July 31, 1999.

ANSWER: Registrant has insufficient knowledge or information to form a belief as to the allegations of this Paragraph of the Petition for Cancellation and therefore denies the same.

6. AvalonBay has undertaken significant efforts to actively promote its trademarks, including spending millions of dollars over the years in advertising and marketing the goods and services offered under the AVALON marks. Additionally, AvalonBay has been recognized numerous times and received multiple awards for high quality and excellence. It has received, among many other awards, the NAREIT Residential Leader in the Light Award, "Property Management Company of the Year" by the National Association of Home Builders, and the Multifamily Executive Awards' "Project of the Year" Award.

ANSWER: Registrant has insufficient knowledge or information to form a belief as to the allegations of this Paragraph of the Petition for Cancellation and therefore denies the same.

7. As a result of AvalonBay's continuous and extensive use, advertising and promotion of the AVALON marks, as well as the distinctiveness of the marks, the AVALON marks have become well-known, and consumers have come to recognize the AVALON marks as uniquely associated with AvalonBay and an indication of origin.

ANSWER: Denied.

8. Registrant is not affiliated with or sponsored by AvalonBay, and Registrant has never been authorized by AvalonBay to use any of the AVALON marks.

ANSWER: Admitted.

9. Registrant's mark AVALON, which is registered under U.S. Trademark Registration No. 4043653 (the "AVALON registered mark") is identical to AvalonBay's AVALON mark and confusingly similar to AvalonBay's other AVALON marks. As such, consumers are likely to be confused, mistaken, or deceived into the belief, contrary to fact, that Registrant's Services offered under the AVALON registered mark emanate from and/or are in some way sponsored or approved by AvalonBay, and/or that Registrant is somehow affiliated with AvalonBay, thereby damaging AvalonBay.

ANSWER: Denied.

10. In addition, Registrant's Services are closely related to those offered by AvalonBay under its AVALON marks.

ANSWER: Denied.

11. Registrant's Services are also likely to be sold to the same or overlapping classes of purchasers and trade channels as goods and services bearing the AVALON marks.

ANSWER: Denied.

12. Because of the high degree of similarity between the parties' respective marks, services, and trade channels, as well as the fame of the AVALON marks in the real estate industry, Registrant's continued registration of the AVALON registered mark is likely to cause consumer confusion, mistake or deception, violating Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

ANSWER: Denied.

13. On the basis of likelihood of confusion, U.S. Trademark Registration No. 4043653, is subject to cancellation under Section 14 of the United States Trademark Act of 1946, 15 U.S.C. § 1064.

ANSWER: Denied.

14. AvalonBay believes that it is being damaged and will be damaged by the continued registration of the AVALON registered mark.

ANSWER: Registrant has insufficient knowledge or information to form a belief as to Petitioner's subjective belief regarding damage and therefore denies the same. Registrant denies all remaining allegations in this Paragraph of the Petition for Cancellation.

AFFIRMATIVE DEFENSES

For its Affirmative Defenses to the Petition for Cancellation, Registrant states as follows:

Affirmative Defense No. 1 – Equitable Estoppel

1. Petitioner's claims are estopped on the grounds that Petitioner has long tolerated third parties' use of AVALON marks in connection with a wide variety of services, including services for which it claims to have registered trademarks. As a result, Petitioner is estopped from asserting its rights, if any, in the AVALON mark.

Affirmative Defense No. 2 – Acquiescence

2. Petitioner's claims are barred by the doctrine of acquiescence on the grounds that Registrant and its predecessor have openly and conspicuously used the AVALON mark in connection with hotel services for many years, including by providing Petitioner with constructive notice via the prosecution and maintenance of Reg. No. 4,043,653. By its failure to object to Registrant's continued use or registration of the AVALON mark in connection with hotel services until recently, Petitioner has acquiesced to Registrant's use and registration.

Affirmative Defense No. 3 – Laches

3. Petitioner's claims are barred by the doctrine of laches on the grounds that Registrant and its predecessor have openly and conspicuously used the AVALON mark in

connection with hotel services for many years, including by providing Petitioner with constructive notice via the prosecution and maintenance of Reg. No. 4,043,653. By its failure to object to Registrant's continued use or registration of the AVALON mark in connection with hotel services until recently, Petitioner is barred by the doctrine of laches from objecting Registrant's use now.

Registrant reserves the right to add additional defenses and to add counterclaims that it may develop through discovery, including without limitation seeking cancellation of Petitioner's purported trademark rights on the grounds described above.

Respectfully submitted,

Dated: December 16, 2015

By: Lee Eulgen

One of the Attorneys for Registrant,
Avalon IP Holdings, LLC

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CERTIFICATE OF SERVICE

It is hereby certified that a true and complete copy of the foregoing Answer to Petition for Cancellation at the correspondence address of record in the United States Patent and Trademark Office by mailing said copy on December 16, 2015, via U.S. Mail, postage prepaid to:

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